

IAP15 Rec'd PCT/PTO 27 SEP 2006

Application No.: 10/549,326
Attorney Docket No.: 1032013-000129

#6

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Driss Stitou et al.

Application No.: 10/549,326

International Filing Date: March 12, 2004

For: METHOD AND DEVICE FOR RAPID
AND HIGH-POWER COLD PRODUCTION

Group Art Unit:

Examiner:

Confirmation No.: 8226

STATEMENT FURTHER TO EXECUTED DECLARATION

Attn: Richard Cole
Office of PCT Legal Administration
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

2 NOV 2006

Legal Staff
International Division

Sir:

In response to the Communication received from the U.S. Patent and Trademark Office dated 14 August 2006 (a copy of which is attached) Applicants submit the following. It is respectfully requested that the attached executed declarations be considered together and as such, be accepted.

Please note that inventor Bernard Spinner is deceased. Accordingly, pursuant to 37 C.F.R. §1.42 and MPEP § 409.01(a), all of his heirs executed the attached declarations on his behalf, as heirs and legal representatives.

The citizenship, residence and mailing address of deceased inventor Bernard Spinner is as follows:

Bernard Spinner
228, rue Einstein
F-66100 Perpignan
France.

The following is a complete list of all heirs and legal representatives of deceased inventor Bernard Spinner with their respective citizenships, residences and mailing addresses:

Bruno Spinner
son of and heir and legal representative to Bernard Spinner
1 rue Rabelais
F-34690 Fabreges
France

Caroline Spinner Brossard
daughter of and heir and legal representative to Bernard Spinner
19 Lotissement Las Trados
F-09000 Brassac
France

Anne Christel Spinner Kohler
daughter of and heir and legal representative to Bernard Spinner
Domaine d'Aussieres
F-11100 Narbonne
France

Camille Spinner
daughter of and heir and legal representative to Bernard Spinner
228, avenue A. Einstein
F-66100 Perpignan
France

Martin Spinner
son of and heir and legal representative to Bernard Spinner
228, avenue A. Einstein
F-66100 Perpignan
France

Please note that two of the heirs, Camille Spinner and Martin Spinner, are the minor children of deceased inventor Bernard Spinner. Their mother Nathalie Mazet has executed on behalf of the minor children, but she is not herself an heir of or legal representative to deceased inventor Bernard Spinner.

There are three attached declarations, two of which are identical but for the signatures obtained thereon. One contains the signatures of heir and legal representative Bruno Spinner, heir and legal representative Caroline Brossard, and heir and legal representative Anne Christel Kohler. The second declaration contains the signatures of inventor Driss Stitou, inventor Olivier Bertrand, and Nathalie Mazet, who has executed the declaration on behalf of the two minor children heirs Camille Spinner and Martin Spinner. Please note that mother Nathalie Mazet is not herself an heir of or legal representative to deceased inventor Bernard Spinner, so she did not execute the declaration on her own behalf.

In the two identical declarations, the citizenship, residence and mailing address of deceased inventor Bernard Spinner is provided. The citizenships, residences and mailing addresses of the heirs executing on behalf of deceased inventor Bernard Spinner are also provided in these declarations with their respective signatures. The citizenship, residence, and mailing address of the two minor children heirs is further provided with mother Nathalie Mazet executing on their behalf.

The third attached declaration is executed by inventor Driss Stitou, inventor Olivier Bertrand, heir and legal representative Bruno Spinner, heir and legal representative Caroline Brossard, heir and legal representative Anne Christel Kohler, Nathalie Mazet who has executed the declaration on behalf of the minor heir Camille Spinner, and heir and legal representative Martin Spinner. This declaration separately lists Camille Spinner and Martin Spinner and individually provides the citizenships, residences and mailing addresses of all of the heirs of deceased inventor Bernard Spinner with their respective signatures.

Accordingly, all of the heirs of deceased inventor Bernard Spinner executed the declarations providing the citizenship, residence and mailing address of deceased inventor Bernard Spinner and the citizenships, residences and mailing addresses of all of the heirs (with the minor children heirs listed together and signed for by mother Nathalie Mazet). All of the heirs of deceased inventor Bernard Spinner also executed the declaration providing the citizenships, residences and mailing addresses of all of the heirs, including the minor children listed separately with mother Nathalie Mazet executing on behalf of minor heir Camille Spinner and Martin Spinner signing on his own behalf.

Therefore, when the declarations are considered together, all of the inventors and heirs of deceased inventor Bernard Spinner have executed a declaration providing both the citizenship, residence and mailing address of the deceased inventor Bernard Spinner and the citizenships, residences and mailing addresses of all of the heirs.

Thus, it is respectfully submitted that the executed declarations, when considered together, satisfy the requirements under 37 C.F.R. § 1.42. As such, it is respectfully requested that the executed declarations be accepted.

If there are any questions regarding this submission, please contact the undersigned.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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Date: September 27, 2006



14 AUG 2006

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In re Application of
Stitou et al.
Application No. 10/549,326
PCT No.: PCT/FR04/00617
Int. Filing Date: 12 March 2004
Priority Date: 18 March 2003
Atty. Docket No.: 032013-129
For: Method And Device For Rapid
And High-Power Cold Production

COMMUNICATION

This is in response to the declaration of the inventors filed on 03 February 2006, which is being treated under 37 CFR 1.42.

BACKGROUND

This international application was filed on 12 March 2004, claimed an earliest priority date of 18 March 2003, and designated the U.S. The International Bureau communicated a copy of the published international application to the USPTO on 07 October 2004. The 30 month time period for paying the basic national fee in the United States expired at midnight on 19 September 2005 (since 18 September 2005 was a Sunday). Applicants filed, *inter alia*, the basic national fee on 16 September 2005.

On 12 December 2005, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the filing of an executed oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge under 37 CFR 1.492(h).

DISCUSSION

Review of the declaration of the inventors filed on 03 February 2005 reveals that joint inventor Bernard Spinner is indicated to be "deceased" and that Bruno Spinner, Caroline Spinner Brossard, Anne Christel Spinner Kohler, Nathalie Mazet and Martin Spinner have signed on his behalf. 37 CFR 1.42 provides in part that

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Meanwhile, 37 CFR 1.497(b)(2), as amended effective 08 September 2000, provides that

If the person making the oath or declaration is not the inventor (§§ 1.42, 1.43 or 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

BUCHANAN INGERSOLL & ROONEY PC

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Req. Reconsideration Due 10-14-06

Further examination of the declaration filed on 03 February 2006 reveals that it provides citizenship, residence and mailing address information for each of the five individuals signing on behalf of Bernard Spinner, but it does not provide "the facts which the inventor would have been required to state" in that Bernard Spinner's citizenship, residence and mailing address information is not listed.

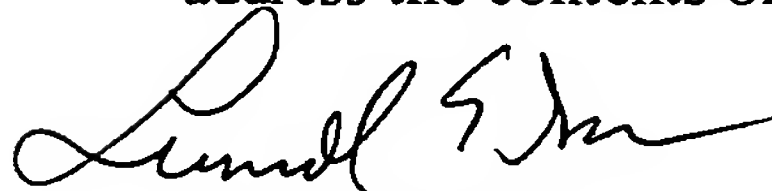
In addition, Bruno Spinner, Caroline Spinner Brossard, Anne Christel Spinner Kohler and Martin Spinner have signed in the capacity of "heir and legal representative to Bernard Spinner," while Nathalie Mazet has signed as "mother of minor Camille Spinner, daughter of and heir and legal representative to Bernard Spinner." There is no affirmative statement that the five signatories (or some other set of individuals) constitute "all" of the heirs and legal representatives of Bernard Spinner. This issue is exacerbated by the fact that applicants have not adequately clarified the status of Nathalie Mazet. Counsel states that "Camille Spinner is a minor, and her mother, Nathalie Mazet, has signed on her behalf." It is not clear whether Ms. Mazet is also an heir, and in what capacity she has signed the declaration (is she representing her own interests as an heir, or only Camille Spinner's interests as an heir, when she signs on behalf of Bernard Spinner? Are both Nathalie Mazet and Camille Spinner "legal representatives" of Bernard Spinner?) The language "mother of minor Camille Spinner, daughter of and heir and legal representative to Bernard Spinner" is particularly unclear; should this be interpreted as "signing on behalf of minor heir Camille Spinner as Camille Spinner's mother, Camille Spinner being a daughter of Bernard Spinner, an heir of Bernard Spinner, and a legal representative of Bernard Spinner, and Nathalie Mazet (also being/not being) an heir and a legal representative of Bernard Spinner"? It is noted that the mere fact that a particular heir may be a minor does not preclude that heir from signing a declaration of inventorship, so long as he or she understands the declaration. As such, if Camille Spinner understands the declaration, it would be appropriate for her to execute it herself. For these reasons, it would not be appropriate to accept the declaration of the inventors under 37 CFR 1.42 at this time.

CONCLUSION

The declaration is **NOT ACCEPTED** under 37 CFR 1.42, without prejudice.

If reconsideration on the merits of this matter is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42." Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the PCT Legal Office.



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